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1077 Northern Boulevard
Roslyn, NY 11576

EXAMINER

ALVAREZ, RAQUEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/589,313

Applicant(s)

SPECTOR, DONALD

Examiner

Raquel Alvarez

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 4/7/2004.
2. Claims 1-12 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. (6,336,099 hereinafter) in view of Von Kohorn (5,249,044 hereinafter Von Kohorn).

With respect to claim 1, Barnett teaches a system for generating discount or promotional coupons (see Abstract). A receiver located at a viewer's premises, said receiver including a communication device (i.e. the user uses personal computer 6 to communicate his coupons request and selections to Online provider 2)(figure 1 and col. 7, lines 1-5),

With respect to the newly added feature of a personal video recorder (PVR) that allows a viewer to select a coupon for a product while it is advertised via a commercial that is displayed by the receiver, and said PVR transmitting the request for said coupon to a data processing device, which transmits, reviews and stores the request to a broadcaster central station (i.e. the coupons viewed and selected by the user is

recorded and transmitted to the coupon distributor)(see Figure 1 and col. 6, lines 66 to col. 7, lines 1-5).

means included within said broadcaster central station for transmitting to a manufacturer coupon generator station a coupon request, which request includes a specific information regarding the product of interest (i.e. the Online service provider 2 transmits the specific coupon request and user's data to the coupon distributor 16)(Figure 1),

first means included within said manufacturer's coupon generator station for receiving specific information regarding said product of interest, said manufacture's coupon generator station also having available point-of-sale information regarding said product (i.e. the coupon distributor receives the specific coupon selection and information from the various retail stores as to which coupons are being redeemed)(Figure 1 and col. 5, lines 28-34),

second means included within said manufacturer's coupon generation station for analyzing said specific information regarding said product of interest, and said point-of-sale information and issuing a coupon to said viewer based on said analyzed information(i.e. the information related to the coupons selected is supplied to the coupon distributor 16, and the information obtained from various retailers stores as to which coupons are redeemed in order to more intelligent market subsequent coupons and target coupon issuance in a more cost effective manner)(col. 5, lines 28-34).

With respect to the feature of receiving up to the minute point-of-sale information on the product of interest and coupon responses and redemptions. Barnett teaches the

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retailer sending (10) sending point-of-sale information on the product purchased and coupon redemption information for the products purchased to the coupon distributor (Figure 1 and col. 5, lines 28-34). Barnett is silent as to how frequent the point of sale information and redemption information is sent. In Barnett the point of sale information on the products of interest and coupon responses and redemption is sent electronically through a computer network (see Figure 1) and since it is old and well known in computer networks to transmit information and receive information instantly and frequently such as up to the minute then it would have been obvious to a person of ordinary skill in the art to have included receiving information on the product of interest and coupon responses and redemptions up to the minute because such a modification would allow to analyze the information received in real time.

Barnett doesn't specifically teach the receiver being a television receiver consisting of a remote control for coupon selection. On the other hand, Von Kohorn teaches a coupon dispensing system wherein the user television receiver 12 and remote control 14 operated by viewer 13 to generate and dispense tokens or coupons 2 (see figure 1). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified the system of Barnett with the teachings of Von Kohorn of the receiver being a television receiver consisting of a remote control for coupon selection because such a modification would increase the usage of the system of Barnett by implementing it in a common device such as a television and a control remote which is already owned by most households.

With respect to claim 2, Barnett further teaches wherein said request for a coupon includes information specifying a time when said coupon is requested (i.e. demographic data file 42 contains data representative of the time that the user requested the coupon package 40).

Claim 3 further recites that the manufacturer's coupon generator station includes means for comparing the time when the coupon was requested with the time when the product of interest was broadcast. Since, Barnett teaches the coupon distributor (manufacturer) receives selection data for when the coupons are selected and the times when the coupon was viewed (broadcast)(Abstract) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included making a comparison between the time when the coupons are requested from when the time when the coupons are broadcasted because such a modification would allow the manufacturer to better target the incentives or coupons to each user based on the user habits.

With respect to claim 4, Barnett further teaches issuing said coupon at a value intended to provide maximum sales of said product of interest (i.e. the manufacture issues the coupon of interest at the redemption amount 74).

With respect to claim 5, the combination of Barnett and Von Kohorn do not specifically teach a value which varies depending on the geographic location of the user. Nevertheless, a customer located in Alaska would have a greater need for a winter coat and therefore the coupon distributor may want to vary the value of the coupon accordingly. It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to have included coupon value which varies depending on the geographic location of the viewer because such a modification would provide a more target system based on the customers needs.

With respect to claim 6, Barnett further teaches that said coupon is short life coupon (i.e. certain coupons have to be used/redeemed within one month from the day printed)(col. 11, lines 66-, col. 12, lines 1-8).

With respect to claim 7, Barnett further teaches that the coupon, upon issuance, is printed for said viewer by a printer attached to said data processing means (Figure 1, item 8).

With respect to claim 8, Barnett further teaches that the coupon, upon issuance is electronically stored by said data processing means (i.e. the coupons are stored in the output buffer 28)(col. 11, lines 30-34)

With respect to claim 9, Barnett further teaches that the electronically stored coupon can subsequently be printed or redeemed electronically by said viewer (i.e. the coupon are redeemed electronically by sending the coupon data in the output buffer via the communications interface 20 back to the Online service provider 2)(col. 11, lines 32-38).

With respect to claim 10, Barnett doesn't specifically teach hat the coupon includes inquiries which may be electronically or manually answered by said viewer as part of a contest. On the other hand, Von Kohorn teaches that a token (coupon) is generated which contains a serial number and customer's information such as the customer's name and that information is used to enter the customers in a contest where

they can win additional prizes (col. 8, lines 19-41). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the system of Barnett the teachings of Von Kohorn of the coupon including inquiries which may be electronically answered by said viewer as part of a contest because such a modification would motivate the customers to supply the requested information.

With respect to claim 11, Barnett further teaches assembling and transmitting consumer profile information along with said information regarding the product of interest (i.e. the demographic file 42 along with the user's product selections is assembled and transmitted to the Online service)(see figure 9).

With respect to claim 12, Barnett further teaches wherein said coupon is a promotional coupon (see Figure 5).

Response to Arguments

4. The 112, 2nd rejection has been withdrawn due to the claim's amendment.

5. Applicant argues that the cited references do not disclose automatic request for a coupon by a television viewer viewing a commercial on a television set. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Barnett teaches automatic request for a coupon viewing a commercial (i.e. the user

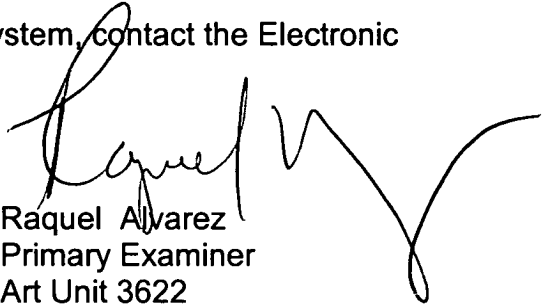
using a personal computer 6 views a commercial for a coupon and request the coupon)(Figure 1). Von Kohorn teaches using a television receiver via a control remote 14 to generate the coupons. Applicant argues that, element 14 of Von Kohorn is not a remote control but a stand-alone coupon generating device that does not control or send request to a television. The Examiner wants to point out that Von Kohorn was merely cited for using a television receiver and a remote control or generating device used for coupon selection (col. 6, lines 66 to col. 7, lines 1-17) . Controlling or sending requests through a device to a broadcaster central station is taught by Barnett (see Figure 1 of Barnett).

Point of contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
8/12/04